

REMARKS

1. An Office Action requiring Applicants to elect a single invention for prosecution on the merits was mailed May 25, 2006. In response to the Election/Restriction Requirement, Applicants submit this Response to Election/Restriction Requirement.

Restriction Requirement

2. The Examiner has required the election of a single invention for prosecution on the merits. The Examiner alleged that the originally filed claims are directed to the following three (3) patentably distinct inventions:

- I.* Claims 1 through 32, drawn to an implantable tissue stimulating prosthesis, classified in class 607, subclass 116.
- II.* Claims 33 through 63, drawn to cochlear implant system with carrier, classified in class 607, subclass 55.
- III.* Claims 64 through 73, drawn to a method of implantation, classified in class 607, subclass 137.

Traversal of Restriction Requirement

3. Applicants respectfully traverse the requirement to restrict the claims pending in the present application prior to entry of this paper. "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02)." (See, MPEP § 803.) Applicants respectfully assert that, for at least the reasons set out below, the above restriction fails to satisfy the above criteria, and should be withdrawn.

***The Examiner Has Failed To Provide Sufficient Reasoning
For Restricting The Claimed Invention***

4. As explained in the MPEP: “Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; ...” (*See*, MPEP § 808; emphasis in original.) “The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.” (*See*, MPEP § 816.)

5. Applicants assert that no such reasoning has been provided to support the outstanding Restriction Requirement. In the current Office Action, the Examiner has asserted that the inventions are distinct because the common utility between claims is not linked to a substantial structural feature. This is incorrect. All independent claims recite a common feature of holding member which facilitates grasping during implantation.

6. The Examiner further asserts that the claimed inventions cannot be practiced to perform a common utility, pointing out the quantity of electrodes of each of the claimed inventions, and noting that the different claimed inventions may be utilized to stimulate different parts of a recipient. Neither rationale is compelling. The quantity of electrodes has no bearing on the claimed holding member, nor does the location of stimulation.

7. The MPEP provides examples of the type of reasoning that should be included to support a restriction requirement. (*See*, for example, MPEP § 816.) Because the outstanding Restriction lacks any such support, Applicants assert the Restriction of is improper and should be withdrawn.

***The Examiner Has Failed To Show The Necessary Burden
To Examine All Pending Claims***

8. As noted above, there must be “a serious burden on the examiner if restriction is required.” (*See*, MPEP § 803.) This is a separate and distinct requirement that must be shown by the Examiner: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (*See*, MPEP § 803.) In the above Restriction Requirement the Examiner has failed to provide any such showing. Further, Applicants respectfully assert that a search performed for any independent claim pending in the application would uncover references potentially relevant to other independent claims. Accordingly, Applicants assert that this burden cannot be met and, for this additional reason, the requirement should be withdrawn.

9. For any one of the above reasons, Applicants respectfully assert that the Examiner has failed to provide a *prima facie* showing that the claims of Groups II and IV are properly subject to restriction. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding Restriction Requirement of these two groups of claims.

Provisional Election

10. In accordance with 37 CFR § 1.143 and MPEP 818.03(b), Applicants hereby provisionally elect, with traverse, the claims of Group I, namely, claims 1-32.

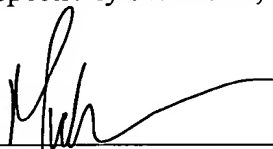
11. Applicants do not intend to dedicate non-elected claims to the public and reserve the right to file divisional applications for the subject matter covered by the non-elected claims.

12. The inventorship for the invention of the elected claims is the same as the inventorship of record in this application.

Conclusion

13. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance and favorable action is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Verga', is written over a horizontal line.

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